

in the text of Paper No. 8. The Examiner contends that the inventions of Groups I and II are distinct *because* they are unrelated. (See, Paper No. 8, ¶ 2). The Examiner summarily states that “[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects.” (*Id.*).

The Examiner argues that the invention of “Group I is related to the method of manufacturing acrylic acid whereas Group II is concerned with the sodium and potassium catalysts.” (See, Paper No. 8, ¶ 2). The Examiner goes on to argue that the invention of “Group I can be performed by a different catalyst other than the sodium and potassium catalysts . . .”. (*Id.*). Presumably, this is the Examiner’s basis for arguing that the inventions of Group I and Group II are unrelated. The Examiner also contends that because the search required for Group I is not required for Group II, and because the inventions have allegedly acquired a separate status in the art, that restriction to one of the two groups is proper. On the basis of these arguments and contentions, the Examiner has required restriction for examination purposes.

Traversal of the Restriction Requirement

Applicants strenuously, but respectfully, traverse the Restriction Requirement for the following reasons.

To begin with, claim 11 is the only independent claim in the pending application, and is directed to a process for producing alkoxylated carboxylic acid esters. Claim 11 reads,

[a] process for the production of alkoxylated carboxylic acid esters comprising reacting a carboxylic acid ester with an alkylene oxide having from 2 to 4 carbon atoms in the presence of a catalyst wherein the catalyst is a mixture comprised of a sodium and a potassium salt selected from the group consisting of hydroxides, oxides, carbonates, alcoholates and carboxylates wherein the weight ratio of the sodium to the potassium salt is from about 20:1 to about 1:20.

It is entirely unclear how the Examiner can assert that claim 11 and claims 12-13, which depend from claim 11, are directed to the manufacture of acrylic acid. Applicants respectfully submit that the Examiner is incorrect.

Moreover, claims 12 through 24 all depend directly or indirectly from claim 11. In other words, all pending claims, claims 11-24, are directed to processes for producing alkoxylated carboxylic acid esters. Claim 14, in which a preferred embodiment of the invention is claimed, depends directly from claim 11 and recites a preferred combination of catalyst components. The catalyst, broadly speaking, is claimed in claim 11 from which claim 14 depends. Contrary to the Examiner's assertions, claims 14-18 are NOT directed to catalysts. As can be seen from the preamble of claims 14-18 (and 12-13 & 19-24 for that matter), each is directed to "the process of claim 11 (or 12 or 14)". There are no claims drawn to a catalyst, *per se*.

Consider the potential election of the Examiner's Group II. If the Examiner were to conduct a search covering the subject matter of claim 14, which reads;

[t]he process of claim 11 wherein the catalyst is comprised of a sodium alcoholate and a potassium salt selected from the group consisting of potassium hydroxide, potassium alcoholate, potassium carboxylate and combinations thereof

how could that search not cover the subject matter of claim 11?

Applicants respectfully submit that claims 11-24 are related and are not drawn to multiple, separate and distinct inventions which require restriction. Therefore, Applicants respectfully submit that restriction between Groups I and II is improper, and further request reconsideration by the Examiner and withdrawal of the Restriction Requirement.

Provisional Election With Traverse

In the event the Examiner maintains the Restriction Requirement set forth in Paper No. 8, Applicants provisionally elect the invention of Group I, claims 11-13, with traverse, for prosecution on the merits. Applicants also request that the remaining, pending claims not addressed in Paper No. 8, claims 19-24, be included in the elected Group.

Respectfully submitted,

ANSGAR BEHLER, et al.

January 2, 2003
(Date)

By: 

AARON R. ETTELMAN

Registration No. 42,516

COGNIS CORPORATION

2500 Renaissance Blvd., Suite 200

Gulph Mills, PA 19046

Telephone: (610) 278-4930

Facsimile: (215) 278-4971

E-Mail: AARON.ETTELMAN@COGNIS-US.COM

ARE:are